

S/N 09/638,638

Response to Office Action Dated 5/4/2004

REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application. Claims 1-27 are pending in this application.

Rejection of the Claims**Rejections under 35 USC § 102(a)**

The Patent Office rejected claims 1-25 and 27 under 35 USC § 102(a) as being anticipated by U.S. Patent No. 5,808,601 to Leah et al. (the "Leah reference" or "Leah"). Applicants amend claims 1, 8, 10, 16, 17, and 23 to more particularly point out and distinctly claim Applicants' subject matter. The claim amendments do not narrow the scope of the amended claims but clarify what is already included in the pre-amended claims. Applicants respectfully submit that the pending claims as amended are patentable over the Leah reference.

Claim 1

The Leah reference does not expressly or inherently describe each element of claim 1.

35 U.S.C. § 102(a) states:

"A person shall be entitled to a patent unless—
... (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent."

In the MPEP § 2131, anticipation under 35 U.S.C. § 102 requires that:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Leah reference discloses an "instantaneous capture" technique for pointing within a GUI to an object that has not yet been "selected" by the user (col. 2, lines 53-58). A perimeter boundary is calculated at a distance around the outside of the object (col. 5, lines 37-47) using a mathematical formula for gravitation (col. 16, lines 16-27). If the visually displayed pointer of an input device, such as a mouse, crosses the perimeter boundary (e.g., a "mouse-over" of an area around the object), then the visually displayed pointer immediately moves "at once" to the "hot or selectable portion of the object" (col. 5, lines 56-63) (emphases added). It should be noted that in the Leah technique, not only has the object not been moved within the GUI by the user, but the object has not even been selected by the user. When the displayed pointer crosses the boundary, "...the visually observable effect is that the virtual mouse selection pointer has become attracted to and is now positioned directly on, the selectable object" (col. 5, line 66 – col. 6, line 2) (emphases added).

On the other hand, Applicants claim 1, as amended, defines a method for use in a graphical user interface, comprising:

"determining an offset value between a selected object's position and an input position; and
dynamically and gradually reducing the offset value by
correctively adjusting the input position with respect to the object's position
in proportion to a movement of the selected object."

According to the method of claim 1, if a user selects an object at an offset distance from the object's preferred contact point (or area) and then moves the object within the GUI (e.g., drags with a mouse), then the offset is selectively and incrementally decreased over time/distance in a manner that is nearly imperceptible to the user.

Leah does not disclose explicitly or inherently one or more elements of "determining an offset value between a *selected* object's position and an input position; and *"dynamically and gradually reducing the offset value by correctively adjusting the input position with respect to the object's position in proportion to a movement of the selected object."*

For example, Leah does not disclose applying an offset correction technique to objects that have already been selected by the user. Further, Leah does not disclose applying offset correction in proportion to an amount of movement of the object. Even further, Leah does not disclose a dynamic and gradual reduction of offset, as the Leah technique moves the displayed pointer "at once" to the center of the object.

Since Leah does not disclose one or more elements of claim 1, Applicants respectfully submit that the Leah reference is not a prior art reference under 35 USC § 102(a). Since the Leah reference is not a prior art reference under 35 USC § 102(a), Applicants submit that claim 1 is patentable over Leah and earnestly seek the allowance of claim 1.

Claims 2-7

For at least the reasons set forth above with respect to claim 1, Applicants submit that claims 2-7 are patentable over the Leah reference.

S/N 09/638,638

Response to Office Action Dated 5/4/2004

Dependent claims contain the language of the claims from which they depend. Claims 2-7 depend from claim 1. Therefore, claims 2-7 are also allowable.

Claim 8

Claim 8 defines a method for use in a graphical user interface. For at least the same reasons explained above with respect to method claim 1, Applicants submit that claim 8 is patentable over the Leah reference and earnestly seek allowance of claim 8.

Claim 9

Claim 9 depends from claim 1. For at least the reasons set forth above with respect to claim 1, Applicants submit that claim 9 is patentable over the Leah reference. Dependent claims contain the language of the claims from which they depend. Since claim 9 depends from claim 1, claim 9 is also allowable.

Claim 10

Claim 10 as amended defines a computer-readable medium having computer executable instructions for causing at least one processing unit to perform acts comprising determining an offset value between a selected object's position and an input position; and in proportion to a movement of the selected object, dynamically and gradually reducing the offset value by correctively adjusting the input position with respect to the object's position.

The Leah reference does not disclose dynamically and gradually reducing the offset value in proportion to a movement of the selected object by correctively adjusting the input position with respect to the object's position.

S/N 09/638,658

Response to Office Action Dated 5/1/2004

Rather, Leah discloses moving a displayed pointer of an input device immediately ("at once") to the "hot or selectable portion of the object" once the pointer crosses a perimeter boundary calculated at a distance around the outside of the object (col. 5, lines 37-47, 56-63) (emphases added).

For at least these reasons, that the Leah reference does not disclose one or more elements of claim 10, Applicants respectfully submit that the Leah reference is not a prior art reference for claim 10 under 35 USC § 102(a). Since the Leah reference is not a prior art reference under 35 USC § 102(a), Applicants submit that claim 10 is patentable over Leah and earnestly seek the allowance of claim 10.

Claims 11-15

For at least the reasons set forth above with respect to claim 10, Applicants submit that claims 11-15 are patentable over the Leah reference. Dependent claims contain the language of the claims from which they depend. Claims 11-15 depend from claim 10. Therefore, claims 11-15 are also allowable.

Claim 16

For at least the same reasons explained above with respect to claim 1, Applicants submit that claim 16 is patentable over the Leah reference and earnestly seek allowance of claim 16.

Claim 17

Claim 17 as amended defines an apparatus comprising logic configured to determine an offset value between a selected object's position and an input position, and dynamically and gradually reduce the offset value by correctively

SN 09/638,658

Response to Office Action Dated 5/4/2004

adjusting the input position with respect to the object's position in proportion to a movement of the selected object.

The Leah reference does not disclose dynamically and gradually reducing the offset value in proportion to a movement of the selected object. On the contrary, Leah discloses a visually displayed pointer of an input device that moves immediately or "at once" to the "hot or selectable portion of the object" once the pointer crosses a perimeter boundary calculated at a distance around the outside of the object (col. 5, lines 37-47, 56-63) (emphases added).

For at least these reasons, that Leah does not disclose one or more elements of claim 17, Applicants respectfully submit that the Leah reference is not a prior art reference for claim 17 under 35 USC § 102(a). Since the Leah reference is not a prior art reference under 35 USC § 102(a), Applicants submit that claim 17 is patentable over Leah and earnestly seek the allowance of claim 17.

Claims 18-22

For at least the reasons set forth above with respect to claim 17, Applicants submit that claims 18-22 are patentable over the Leah reference. Dependent claims contain the language of the claims from which they depend. Claims 18-22 depend from claim 17. Therefore, claims 18-22 are also allowable.

Claim 23

For at least the same reasons explained above with respect to claim 1, Applicants submit that claim 23 is patentable over the Leah reference and earnestly seek allowance of claim 23.

S/N 09/638,658

Response to Office Action Dated 5/4/2004

Claims 24-25

For at least the reasons set forth above with respect to claim 23, Applicants submit that claims 24-25 are patentable over the Leah reference. Dependent claims contain the language of the claims from which they depend. Claims 24-25 depend from claim 23. Therefore, claims 24-25 are also allowable.

Claim 27

For at least the reasons set forth above with respect to claim 17, Applicants submit that claim 27 is patentable over the Leah reference. Dependent claims contain the language of the claims from which they depend. Claim 27 depends from claim 17. Therefore, claim 27 is also allowable.

Rejection Under 35 U.S.C. § 103(a)

Claim 26 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Leah in view of U.S. Patent No. 5,870,083 to Shieh (hereafter, "Shieh").

The Patent Office Has Not Established A Prima Facie Case Of
Obviousness Under 35 U.S.C. § 103(a)

35 U.S.C. § 103(a) states:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the

S/N 09/638,658

Response to Office Action Dated 5/4/2004

prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

To establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellants' disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claim 26 depends from claim 20, which in turn depends from base claim 17. The features of claim 26, including the features of claims 20 and base claim 17 are not taught or suggested by a combination of Leah and Shieh.

Base claim 17 as amended defines an apparatus comprising logic configured to determine an offset value between a selected object's position and an input position, and dynamically and gradually reduce the offset value by correctively adjusting the input position with respect to the object's position in proportion to a movement of the selected object. The Leah reference does not teach or suggest claim 17's element of dynamically and gradually reducing the offset value in proportion to a movement of the selected object. In fact, Leah teaches away from this element of claim 17 because Leah teaches that if a visually displayed pointer of an input device crosses a perimeter boundary calculated at a distance around the outside of the object (col. 5, lines 37-47), then the visually displayed pointer immediately moves—"at once" to the "hot or selectable portion of the object" (col. 5, lines 56-63) (emphases added).

S/N 09/638,638

Response to Office Action Dated 5/4/2004

No teaching or suggestion to move the displayed pointer gradually and in proportion to movement of the object is found in the Leah reference.

The Shieh reference teaches an apparatus including an input device with a touch screen, but Shieh does not teach or suggest claim 17's element of dynamically and gradually reducing the offset value in proportion to a movement of the selected object. The touch screen of Shieh does not add anything to the missing teaching (it too fails to teach or suggest the features of claim 17), hence the combination fails to produce a prima facie obviousness rejection.

Applicants respectfully request that the obviousness rejection be removed from claim 26 and earnestly seek its allowance.

S/N 09/638,658

Response to Office Action Dated 5/4/2004

CONCLUSION

Applicants respectfully suggest that claims 1-27 are in condition for allowance. Applicants respectfully request reconsideration and issuance of the subject application. Should any matter in this case remain unresolved, the undersigned attorney respectfully requests a telephone conference with the Examiner to resolve any such outstanding matter.

Respectfully Submitted,

Date: 5-22-04

By: Mark C. Farrell
Lee & Hayes P.L.L.C.
Mark C. Farrell
Reg. No. 45,988
(509) 324-9256